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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/813,116

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Shun-ichi Miyazaki

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7590

06/27/2008

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EXAMINER

LE, THI Q

ART UNIT

PAPER NUMBER

2613

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/813,116	Applicant(s) MIYAZAKI ET AL.	
	Examiner THI Q. LE	Art Unit 2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in response to Applicant's amendment filed on 4/11/2008. **Claims 4-13** are still pending in the present application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 4, 6, 7, 9 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagata (US Patent # 3,659,159)** in view of **Koichi et al. (JP11068541)**.

Consider **claim 4**, Nagata clearly shows and discloses, an optical signal processing apparatus comprising: at least one photodiode (read as, photoelectric conversion element 42 (note, the operation of the circuit of figure 4 is the same as that of figure 3; thus the photoelectric conversion element 42 can also be a photodiode, column 3 lines 67-70); figure 4) for converting an optical signal to an electrical signal; and a resonant tunneling diode (read as, tunneling diode 43; figure 4) having one end connected to the one end of this resistor (note, the resistor 49 is connected to tunneling diode 43, when the switch is closed; figure 4); wherein a digital signal is acquired by switch operation of the resonant tunneling diode (column 2 lines 65-75) (figure 4; column 3 lines 51-67; column 2 lines 65-75). Nagata disclosed a photo-conversion element 42 is connected to the resistor 49; but fails to disclose, a resistor having its one end directly connected to an anode of this photodiode.

In related art Koichi discloses, a high speed optic/electric conversion apparatus. Wherein, the apparatus includes, a resistor having its one end directly connected to an anode of this photodiode (drawing 5 shows, a photodiode 1 is configured to have its anode directly connected to resistor 7; paragraphs 0013-0016).

It would have been obvious for a person of ordinary skill in the art at the time of the invention to modify the configuration of Nagata (e.g. figure 4) to the configuration taught by Koichi. Since, Koichi teaches an apparatus that is capable of converting optical signal into

electrical signal at high speed; thus expanding the applications the device to high speed communications.

Note, it has been held that the definition of a photodiode is "a type of photoelectric component that detects optical signals and converts them into electrical signals. In column 3 lines 52-70, Nagata explicitly defined "a photoelectric conversion element 42" and explained "input light 41 is converted into a current by the conversion element 42".

Consider **claim 6, and as applied to claim 4 above**, Nagata modified by Koichi further discloses, wherein an electrical signal is acquired by the switch operation of the resonant tunneling diode (figure 3; column 2 line 65- column 3 line 16).

Consider **claim 7**, Nagata clearly shows and discloses, an optical signal processing apparatus comprising: at least one photodiode (read as, photoelectric conversion element 42; figure 4) for converting an optical signal to an electrical signal; a resonant tunneling diode (read as, tunneling diode 43; figure 4) having its one end connected to the one end of this resistor (note, the resistor 49 is also connected to tunneling diode 43, when the switch is closed; figure 4); and a second resistor (read as, resistor 47; figure 4) having its one end connected to the other end of the resonant tunneling diode; wherein a digital signal is acquired by switch operation of the resonant tunneling diode (column 2 lines 65-75) (figure 4; column 3 lines 51-67; column 2 lines 65-75). Nagata disclosed a photo-conversion element 42 is connected to the resistor 49; but fails to disclose, a first resistor having its one end directly connected to an anode of this photodiode.

In related art Koichi discloses, a high speed optic/electric conversion apparatus. Wherein, the apparatus includes, a first resistor having its one end directly connected to an anode

of this photodiode (drawing 5 shows, a photodiode 1 is configured to have its anode directly connected to resistor 7; paragraphs 0013-0016).

It would have been obvious for a person of ordinary skill in the art at the time of the invention to modify the configuration of Nagata (e.g. figure 4) to the configuration taught by Koichi. Since, Koichi teaches an apparatus that is capable of converting optical signal into electrical signal at high speed; thus expanding the applications the device to high speed communications.

Note, it has been held that the definition of a photodiode is "a type of photoelectric component that detects optical signals and converts them into electrical signals. In column 3 lines 52-70, Nagata explicitly defined "a photoelectric conversion element 42" and explained "input light 41 is converted into a current by the conversion element 42".

Consider **claim 9, and as applied to claim 7 above**, claim 9 is rejected for the same reason as claim 6 above.

Consider **claim 12, and as applied to claims 4 and 6 above**, Nagata modified by Koichi further discloses, wherein at least the photodiode (Nagata discloses, photo-conductive element PE; figure 9j) and the resonant tunneling diode (Nagata discloses, tunneling diode TD; figure 9j) are formed on the same semiconductor substrate (Nagata, figure 9j; column 5 lines 30-71).

Consider **claim 12, and as applied to claims 7 and 9 above**, claim 12 is rejected for the same reason as claim 12 applied to claims 4 and 6, above.

1. **Claims 5, 8, 12 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagata (US Patent # 3,659,159)** in view of **Koichi et al. (JP11068541)** and further in view of **Moise et al. (US Patent # 6,008,917)**.

Consider **claim 5, and as applied to claim 4 above**, Nagata modified by Koichi disclosed a light emitter 32, as shown in figure 3, and the invention as described above; Nagata differs from the present invention in that it does not disclose an optical modulator connected to the one end of the resonant tunneling diode, changing its transmittance, and modulating and outputting light.

In related art, Moise et al. disclose an optical modulator (read as, lasing device 16; figure 1) connected to the one end of the resonant tunneling diode, changing its transmittance, and modulating and outputting light (note, the lasing device generates and modulates an output light in response to the first and second voltage levels from the tunneling diode) (figure 1; abstract; column 2 lines 1-5).

It would have been obvious for a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Moise et al. with Nagata modified by Koichi. Because, having a constant output of light while modulating the constant light source using an integrated or externally modulator provides higher transmission bit-rate.

Consider **claim 12, and as applied to claim 5 above**, claim 12 is rejected for the same reason as claim 12 applied to claims 4 and 6, above.

Consider **claim 13, and as applied to claims 5 above**, Nagata as modified by Koichi and Moise et al. further disclose, wherein at least the photodiode (read as, photo-conductive element PE; Nagata, figure 9j), the resonant tunneling diode (read as, tunneling diode TD; Nagata, figure 9j) and the optical modulator (read as, laser diode LD; Nagata, figure 9j) are formed on the same semiconductor substrate (Nagata, figure 9j; column 5 lines 30-71).

Consider **claim 8 and as applied to claim 7 above**, claim 8 is rejected for the same reason as claim 5 above.

Consider **claim 12, and as applied to claim 8 above**, claim 12 is rejected for the same reason as claim 12 applied to claims 4 and 6, above.

Consider **claim 13, and as applied to claim 8 above**, claim 13 is rejected for the same reason as claim 13 applied to claim 5, above.

1. **Claims 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagata (US Patent # 3,659,159)** in view of **Koichi et al. (JP11068541)** and further in view of **Cornely et al. (US Patent # 3,319,080)**.

Consider **claim 10, and as applied to claims 4, 6, 7, 9 above**, Nagata modified by Koichi disclosed the invention as described above, except for, wherein the photodiodes are provided at least in parallel.

In related art, Cornely et al. disclose, wherein the photodiodes (read as, photodiodes 18; figure 1) are provided at least in parallel (figure 1, column 2 lines 30-41).

It would have been obvious for a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Cornely et al. with Nagata modified by Koichi. Because, using a plurality of photodiode allow for receiving a plurality of signal for processing.

2. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagata (US Patent # 3,659,159)** in view of **Koichi et al. (JP11068541)** and further in view of **Amano et al. (US Patent # 5,451,767)**.

Consider **claim 11, and as applied to claims 4, 6, 7, 9 above**, Nagata modified by Koichi disclosed the invention as described above, except for, wherein the photodiodes are provided at least in series.

In related art Amano disclose an optical modulator gate array. Wherein the photodiodes are provided at least in series (read as, the photodiodes PD1-PDn are connected in series with each other to form a logical NAND gate operation; figure 32a, column 28 lines 52-67).

It would have been obvious for a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Amano with Nagata modified by Koichi. Since the structural formation of the array of photodiodes allows for logical operation (i.e. NAND, OR, AND, etc) of the optical modulator.

3. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagata (US Patent # 3,659,159)** in view of **Koichi et al. (JP11068541)** and further in view of **Moise et al. (US Patent # 6,008,917)** and further in view of **Cornely et al. (US Patent # 3,319,080)**.

Consider **claim 10, and as applied to claim 5 above**, Nagata as modified by Koichi and Moise disclosed the invention as described above, except for, wherein the photodiodes are provided at least in parallel.

In related art, Cornely et al. disclose, wherein the photodiodes (read as, photodiodes 18; figure 1) are provided at least in parallel (figure 1, column 2 lines 30-41).

It would have been obvious for a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Cornely et al. with Nagata as modified by Koichi and Moise. Because, using a plurality of photodiode allow for receiving a plurality of signal for processing.

Consider **claim 10, and as applied to claim 8 above**, claim 10 is rejected for the same reason as claim 10 applied to claim 2, above.

4. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagata (US Patent # 3,659,159)** in view of **Koichi et al. (JP11068541)** and further in view of **Moise et al. (US Patent # 6,008,917)** and further in view of **Amano et al. (US Patent # 5,451,767)**.

Consider **claim 11, and as applied to claims 5 above**, Nagata as modified by Koichi and Moise disclosed the invention as described above, except for, wherein the photodiodes are provided at least in series.

In related art Amano disclose an optical modulator gate array. Wherein the photodiodes are provided at least in series (read as, the photodiodes PD1-PDn are connected in series with each other to form a logical NAND gate operation; figure 32a, column 28 lines 52-67).

It would have been obvious for a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Amano with Nagata as modified by Koichi and Moise. Since the structural formation of the array of photodiodes allows for logical operation (i.e. NAND, OR, AND, etc) of the optical modulator.

Consider **claim 11, and as applied to claim 8 above**, claim 11 is rejected for the same reason as claim 11 applied to claim 5, above.

Response to Arguments

5. Applicant's arguments with respect to claims 4-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

8. Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Thi Le whose telephone number is (571) 270-1104. The Examiner can normally be reached on Monday-Friday from 7:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kenneth Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Thi Le

/Kenneth N Vanderpuye/
Supervisory Patent Examiner, Art Unit 2613